

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 6 of 16

### **REMARKS**

In response to the Non-Final Office Action mailed August 25, 2005 (hereinafter "Office Action"), claims 8-9 have been amended, and claim 27 has been newly added. No claims have been cancelled. Therefore, claims 8-9, and 17-27 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

### **DRAWINGS**

The six (6) attached sheets of drawings in **APPENDIX A** replace the five (5) sheets depicting FIGS. 1, 2A, 2B, 3, & 4 that were filed with the above-referenced application on September 16, 2003, and the one (1) sheet depicting FIGS. 5A-5B that was submitted by Applicants via an Amendment dated April 14, 2005. The April 14, 2005 Amendment introducing FIGS. 5A-5B has been entered by the Examiner. *See* 04/22/05 Advisory Action.

### **REJECTIONS UNDER 35 U.S.C. §112**

Claims 8 and 17-21 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential elements, such omission amounting to a gap between the elements. In particular, the Examiner alleges that the "*omitted elements are: a device for personalizing the object with an audible message.*" *See* Office Action at pg. 2, ¶2.

Applicants disagree with the propriety of this rejection. However, claim 8 has been

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 7 of 16

amended solely in an effort to expedite prosecution. As such, withdrawal of this rejection is earnestly sought.

### REJECTIONS UNDER 35 U.S.C. §§102-103

#### A. Independent Claim 8, and dependent Claims 17-21.

##### 1. *Phillips and Haufler.*

Claim 8 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0109596 A1 to Phillips *et al.* ("Phillips"). *See* Office Action at pg. 2, ¶4. Claims 17-19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Phillips in view of U.S. Patent No. 6,289,903 to Haufler. *See* Office Action at pg. 4, ¶7. Applicants traverse these rejections for the reasons set forth in detail herein.

##### a. Claim 8.

The rejection of claim 8 under 35 U.S.C. §102(b) is improper for *at least* the reason that Phillips neither explicitly nor impliedly discloses each of the features of claim 8. For example, claim 8 recites, *inter alia*, the feature of "...the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another." Phillips fails to disclose *at least* this feature.

Phillips discloses interactive jewelry, wherein each jewelry item (*e.g.*, ring 100 and ring 102) includes a self-powered transmitter-sensor-responder ("TSR") unit (*e.g.*, TSR unit 104 and TSR unit 105). When rings 100 and 102 are brought within a certain proximity to

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 8 of 16

one another, but before physical adjacency, a mutual response (e.g., an audible or visual indication) between the TSR units (104, 105) is generated. See Phillips at, e.g., FIG. 1; ¶'s 0007-0008; and ¶0015.

Phillips fails to disclose that each jewelry item comprises a connecting mechanism so as to enable multiple jewelry items from different pairs of jewelry items to be directly, physically linked to one another. At best, Phillips discloses that physical adjacency is optional using a system similar to that disclosed in U.S. Patent No. 6,050,695 to Fromm:

"Fromm system" as used herein means a system similar to that shown in U.S. Pat. No. 6,050,695 to Fromm that, unlike TSRs that are remotely activated, is not activated by proximity but instead requires adjacency, i.e. physical contact or interengagement, to cause an electrical circuit to close. **Phillips at ¶0013.**

...  
An additional function could be added that would only be triggered by physical adjacency as in Fromm, but that is optional. **Phillips at ¶0008.**

...  
There could be added to any of the interactive jewelry noted above a Fromm system, although the TSRs are more versatile in application due to the variety of signals which can be transmitted. **Phillips at ¶0027.**

Accordingly, it *appears* from the disclosure of Phillips as though "physical adjacency" in Phillips could be achieved using a "Fromm system." Applicants have previously presented arguments identifying the deficiencies of Fromm, particularly Fromm's failure to disclose at least the feature of enabling multiple friendship objects from different pairs of friendship objects to be linked together. See 10/13/04 Response to Non-Final Office Action (at pgs. 6-7), and 06/10/05 Appeal Brief (at pgs. 5-7). Phillips also appears to acknowledge this shortcoming of Fromm:

For example, in U.S. Pat. No. 6,050,695 to Fromm, one of the jewelry items is provided with an electrical display with an open electrical circuit and requires the presence of **another matching jewelry item** to contact the open electrical circuit to complete the circuit and initiate the operation of the electrical display. The preferred electrical display in Fromm is a light placed under a

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 9 of 16

translucent stone in a ring. The electrical contacts are either specially shaped to make a given ring only engage with a particular matching ring or are magnetic switches. We might term these "engagement rings." Phillips at ¶0005, **emphasis added**.

As such, Phillips does not disclose the feature of "...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*" There is no structure described or illustrated in Phillips that appears to satisfy this claim feature. Moreover, modifying Phillips to include a "Fromm system" as suggested by Phillips would fail at least because of the deficiencies of Fromm previously made of record by Applicants.

Accordingly, the rejection of claim 8 under 35 U.S.C. §102(b) is improper and should be withdrawn.

b. Claims 17-19.

Applicants traverse the rejection of dependent claims 17-19 for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness. There exists no teaching, suggestion, or motivation to modify Phillips to include the teachings of Haufler. Assuming arguendo that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Phillips and Haufler, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Haufler does not cure the deficiencies in the disclosure of Phillips articulated in detail above (with regard to independent claim 8) concerning Phillips' failure to disclose the feature of "...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*" Accordingly, the rejection of claims

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 10 of 16

17-19 is improper and should be withdrawn.

2. ***Coleman, Haufler, and Ford.***

Claims 8 and 20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,223,559 to Coleman. *See* Office Action at pg. 3, ¶5. Claims 17-19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Coleman in view of Haufler. *See* Office Action at pg. 4, ¶8. Claim 21 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Coleman in view of U.S. Patent No. 6,445,132 to Ford. *See* Office Action at pg. 5, ¶9. Applicants traverse these rejections for the reasons set forth in detail herein.

a. Claims 8 and 20.

The rejection of claim 8 under 35 U.S.C. §102(b) is improper for *at least* the reason that Coleman neither explicitly nor impliedly discloses each of the features of claim 8. Claim 8 recites, *inter alia*, the feature of “...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*” Coleman fails to disclose *at least* this feature.

Coleman discloses a medical identification charm bracelet (10) comprising a bracelet band (20) with various charm attachments (40). *See* Coleman, *e.g.*, FIGS. 1-2; and col. 2, lines 3-8. The bracelet (10) includes charm rod hinges (22) with carabiner style locks (26). A user can open the charm rod hinges (22) to connect a charm attachment (40) via a ring type clip (42). The carabiner style locks (26) keep the charm attachments (40) from falling off the bracelet (10). *See* Coleman, *e.g.*, FIGS. 1-2; and col. 2, lines 15-22.

Applicant: JACQUIN *et al.*

Serial No: 10/662,327

Filing Date: September 16, 2003

Page: 11 of 16

Accordingly, while Coleman discloses enabling a charm attachment (40) to be connected to a charm rod hinge (22) via a ring-type clip (42), Coleman does not disclose enabling charm attachments (40) from different pairs of charm attachments to be directly, physically linked to one another.

For at least this reason, the rejection of claim 8 under 35 U.S.C. §102(b) is improper and should be withdrawn.

b. Claims 17-19.

Applicants traverse the rejection of dependent claims 17-19 for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness. There exists no teaching, suggestion, or motivation to modify Coleman to include the teachings of Haufler. Assuming arguendo that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Coleman and Haufler, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Haufler does not cure the deficiencies in the disclosure of Coleman articulated in detail above (with regard to independent claim 8) concerning Coleman's failure to disclose the feature of "...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*" Accordingly, the rejection of claims 17-19 is improper and should be withdrawn.

c. Claim 21.

Applicants traverse the rejection of dependent claim 21 for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness. There exists no teaching, suggestion, or motivation to modify Coleman to include the teachings of Ford. Assuming

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 12 of 16

arguendo that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Coleman and Ford, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Ford does not cure the deficiencies in the disclosure of Coleman articulated in detail above (with regard to independent claim 8) concerning Coleman's failure to disclose the feature of "*...the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*" Accordingly, the rejection of claim 21 is improper and should be withdrawn.

For *at least* each of the foregoing reasons, independent claim 8 is patentable over Phillips, and patentable over Coleman. Dependent claims 17-21 are allowable because they depend from allowable independent claim 8, as well as for the further limitations they contain. Should the Examiner maintain the rejections, Applicants expressly reserve the right to present additional arguments highlighting additional deficiencies in the Phillips, Coleman, and Haufler references, as well as their alleged combinations.

Applicants further expressly reserve the right to challenge the Examiner's assertion (in the Office Action at pg. 3, ¶5) that "*the method by which the kit is being used is not germane to the patentability of the kit,*" as well as the Examiner's characterization of Applicants' Specification (*see* Office Action, pg. 5, ¶9). It is not necessary to address either issue at this time, as claims 8 and 17-21 are patentable over the references of record *for at least* the reasons set forth herein.

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 13 of 16

B. Independent Claim 9, and Dependent Claims 22-26.

1. *Phillips and Haufler.*

Claim 9 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Phillips. See Office Action at pg. 2, ¶4. Claims 22-24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Phillips in view of Haufler. See Office Action at pg. 4, ¶7.

a. Claim 9.

The rejection of claim 9 under 35 U.S.C. §102(b) is improper for *at least* the reason that Phillips neither explicitly nor impliedly discloses each of the features of claim 9. Claim 9 recites, *inter alia*, the feature of “...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*” As discussed in detail above with regard to the rejection of independent claim 8, Phillips fails to disclose *at least* this feature.

In the Office Action, at pg. 3, the Examiner also alleges that the TSR unit of Phillips as disclosed in ¶0019 (at pg. 2, bottom of col. 1 – top of col. 2) comprises a voice recording and playback mechanism. Applicants disagree. The portion of Phillips relied upon by the Examiner discloses that a data stream could be incorporated into signals (211) and (212) and that sensor (209) of TSR (204) could be programmed so as to require a particular data string to be received by sensor (209) to activate responder (210). Responder (210) could likewise be programmed to respond with a data stream to produce, on TSR (216), an audio stream. Producing an audio stream in response to a received data stream is not a voice recording and



Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 14 of 16

playback mechanism as disclosed and claimed by Applicants, and as understood by those having skill in the art.

For *at least* each of the foregoing reasons, the rejection of claim 9 under 35 U.S.C. §102(b) is improper and should be withdrawn.

b. Claims 22-24.

Applicants traverse the rejection of dependent claims 22-24 for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness. There exists no teaching, suggestion, or motivation to modify Phillips to include the teachings of Haufler. Assuming arguendo that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Phillips and Haufler, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Haufler does not cure the deficiencies in the disclosure of Phillips articulated in detail above concerning Phillips' failure to disclose the feature of "...the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another." Accordingly, the rejection of claims 22-24 is improper and should be withdrawn.

2. *Coleman, Tano, Haufler, and Ford.*

Claims 9 and 25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Coleman in view of U.S. Patent No. 6,439,723 to Tano. *See* Office Action at pg. 5, ¶10. Claims 22-24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Coleman and Tano, further in view of Haufler. *See*

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 15 of 16

Office Action at pg. 6, ¶11. Claim 26 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Coleman and Tano, further in view of Ford. *See* Office Action at pg. 7, ¶12. Applicants traverse these rejections for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness.

With regard to independent claim 9, there exists no teaching, suggestion, or motivation to modify Coleman to include the teachings of Tano. Assuming arguendo that there was a proper teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Coleman and Tano, even when combined, fail to disclose, teach or suggest all of the claim elements.

Specifically, the addition of Tano does not cure the deficiencies in the disclosure of Coleman articulated in detail (with regard to independent claim 8) above concerning Coleman's failure to disclose the feature of "...*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be directly, physically linked to one another.*" Accordingly, the rejection of claim 9 is improper and should be withdrawn.

Dependent claims 22-26 are allowable because they depend from allowable independent claim 9, as well as for the further limitations they contain.

Should the Examiner maintain the rejection of claims 9 and 22-26, Applicants expressly reserve the right to present additional arguments highlighting additional deficiencies in the Phillips, Coleman, Tano, Haufler, and Ford references, as well as their alleged combinations.

Applicants further expressly reserve the right to challenge the Examiner's assertion (in the Office Action at pg. 6) that "*the method by which the kit is being used is not germane to*

Applicant: JACQUIN *et al.*  
Serial No: 10/662,327  
Filing Date: September 16, 2003  
Page: 16 of 16

*the patentability of the kit,"* as well as the Examiner's characterization of Applicants' Specification (*see* Office Action, pg. 7, ¶12). It is not necessary to address either issue at this time, as claims 9 and 22-26 are patentable over the references of record *for at least the* reasons set forth herein.

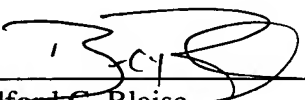
### **CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

By:

  
\_\_\_\_\_  
Bradford C. Blaise  
Registration No. 47,429

Date: December 27, 2005

### **PILLSBURY WINTHROP SHAW PITTMAN LLP**

P.O. Box 10500  
McLean, Virginia 22102  
Direct Dial: 703-770-7741  
Main: 703-770-7900  
Fax: 703-770-7901

Applicant: JACQUIN *et al.*

Serial No: 10/662,327

Filing Date: September 16, 2003

Page: 2 of 16

**AMENDMENTS TO THE DRAWINGS:**

- There are six (6) attached sheets of drawings in **APPENDIX A**.
- The first five (5) sheets of drawings replace the sheets depicting FIGS. 1, 2A, 2B, 3, & 4 that were filed with the above-referenced application on September 16, 2003.
- The sixth (6<sup>th</sup>) attached drawing sheet replaces the sheet depicting FIGS. 5A-5B that was submitted by Applicants with an Amendment dated April 14, 2005.

**APPENDIX A:** Replacement Sheets for FIGS. 1, 2A, 2B, 3, 4, & 5A-5B.

Response Dated: December 27, 2005

Applicant: JACQUIN *et al.*

Serial No: 10/662,327

Filing Date: September 16, 2003

# **APPENDIX A**